

ESTTA Tracking number: **ESTTA1167367**

Filing date: **10/21/2021**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92075974
Party	Plaintiff AH License ApS
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Date	10/21/2021
Attachments	Response to Medela Motion for Protective Order.pdf(263361 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

AH LICENSE APS,

PETITIONER,

v.

MEDELA HOLDING AG,

REGISTRANT.

CANCELLATION NO. 92075974

REG. NO.: 4915973

**PETITIONER’S RESPONSE IN OPPOSITION
TO REGISTRANT’S MOTION FOR PROTECTIVE ORDER**

Petitioner, AH License, ApS, (“Petitioner”) through counsel and pursuant to 37 CFR § 2.120(g) and Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) § 526, hereby responds in opposition to Registrant, Medela Holding AG’s (“Registrant”) Motion for Protective Order, and in support states as follows:

I. Introduction and Background

On September 13, 2021, Petitioner filed a motion to compel Registrant’s production of documents to Petitioner’s First Set of Requests for Production to Registrant (“Production Requests”). TTAB Dkt. 11. At the time the motion to compel was filed, Petitioner had spent over ninety (90) days-time working in good faith to obtain the documents responsive to the Production Requests from Registrant. *See id.* Registrant’s counsel advised on July 22, 2021, that the delay in transmission of the documents to Petitioner’s counsel was due to Registrant’s hesitancy to participate in the TTAB’s discovery process. *See* TTAB Dkt. 11, Markert Declaration at ¶ 9. While not expressly stated, it appeared that Registrant would happily continue to delay the process absent Petitioner seeking the Board’s involvement to compel production.

Registrant, in its Response to Petitioner's Motion to Compel, states that many of the responsive documents were produced contemporaneously with Registrant's filing of Registrant's Response to Petitioner's Motion to Compel / Registrant's Motion for Protective Order. TTAB Dkt. 13. As to the remaining documents, Registrant seeks a Motion for Protective Order requesting the Board (a) permit Registrant to withhold production of relevant and responsive documents, or (b) require Petitioner to subpoena an undisclosed third-party. *Id.* The rationale provided in Registrant's Motion for Protective Order is information new to, and never previously presented to, Petitioner.

II. Legal Standard

A party from whom discovery is sought may file a motion with the TTAB seeking an order to "protect a party from annoyance, embarrassment, oppression, or undue burden or expense, including one or more types of orders provided by clauses (A) through (H), inclusive of Rule 26(c)(1) of the Federal Rules of Civil Procedure." 37 CFR § 2.120(g).

Upon institution of an action, the TTAB's standard protective order is automatically imposed on the parties to the proceeding. 37 CFR § 2.116(g); TBMP § 412. The parties may stipulate, with Board approval, to an alternative order. *Id.* Absent an alternative order, the standard protective order provides for two classes of protected information, "Confidential" (material to be shielded by the Board from public access) and "Confidential – Attorneys Eyes Only (Trade Secret/Commercially Sensitive)" (material to be shielded by the Board from public access and restricted from access by the parties).

The TBMP is abundantly clear that a party is not permitted to "withhold properly discoverable information on the basis of confidentiality since the terms of the Board's standard protective order automatically apply." *See, e.g. Intex Recreation Corp. v. The Coleman Co.*, 117

USPQ2d 1799, 1801 (TTAB 2016) (party may not redact confidential information from documents responsive to document requests); TBMP § 412.01.

A party from whom discovery is sought who seeks a protective order from the Board must establish good cause for its request. *Id.* Further, prior to filing a motion for protective order the requesting party should confer with the opposing party, “in good faith before seeking Board intervention.” TBMP § 412.06; F.R.Civ.P. 26(c)(1). “A motion for protective order may be denied on the basis of a lack of good faith effort to resolve the issues regarding the discovery requests.” TBMP § 412.06.

III. Analysis

a. **No Good Faith Attempt to Confer**

Fed. R. Civ. P. 26(c)(1) requires the party moving for a protective order to confer in good faith or attempt to confer with the other party to resolve the dispute. *See* TBMP § 412.06, *see e.g., Emilio Pucci International BV v. Sachdev*, 118 USPQ2d 1383, 1386 (TTAB 2016) (no good faith effort found). The absence of a good faith effort by the moving party is sufficient to warrant the Board’s denial of the protective order sought.

Here, Registrant made no effort to resolve the alleged issue as to whether certain documents relevant to the proceeding may be produced under the standard protective order without modification. Indeed, the issue was only first raised in a responsive and reactive manner to Petitioner’s motion to compel Registrant to produce responsive documents to discovery demands. Registrant’s failure to attempt to confer at all, let alone in good faith, is sufficient reason for the Board to deny Registrant’s motion.

b. Registrant's Request for Protective Order is without Good Cause

As the moving party, Registrant must establish good cause for the protective order based on particular and specific facts. TBMP § 412.06 *citing The Phillies v. Philadelphia Consolidated Holding Corp.*, 107 USPQ2d 2149, 2152-53 (TTAB 2013); *FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759, 1761 (TTAB 1999).

Petitioner observes that Registrant appears to be exhibiting a pattern of employing tactics to delay prosecution of the case. Registrant previously filed a motion for extension of time to respond to discovery requests asserting four reasons why the Board should grant the extension. Dkt. 5. One of the reasons – Registrant's attorney's health condition – warranted, without further inquiry, the extension sought, resulting in Petitioner consenting to that motion. Dkt. 6. However, the Board need not have been brought into that discovery dispute had Registrant's counsel merely disclosed the health information to Petitioner's counsel *prior* to Registrant's counsel filing that motion. *See* Dkt. 6 at pg. 4-5. However, as in the present situation, Registrant's counsel elected not to disclose vital information when seeking the extension request from Petitioner's counsel, opting instead to disclose a personal health condition in a public manner through filing that motion with the Board.

Likewise, we again find the parties requiring the Board's intervention in discovery matters because of Registrant's refusal or inability to participate in the proceeding. Registrant's motion is void of any good cause statement of particular facts and circumstances which would render the standard protective order inadequate. Indeed, there is no specificity as to the nature of the documents other than a broad and sweeping generalization that "[a] good portion of the documents *responsive* to Petitioner's document requests involve or relate to an agreement between Registrant's predecessor-in-interest, Lamprecht Ltd., and a third party." Dkt. 13

(emphasis added). Further, Registrant does not identify the harm that would result from disclosure under the standard protective order (e.g., utilizing a Confidential – AEO designation).

What is clear, is that Registrant does not dispute the relevancy of the documents for Petitioner to prepare its case. For at least these reasons, it is readily apparent that Registrant is merely seeking to delay production of documents and to harass Petitioner. *See Emilio Pucci International BV v. Sachdev*, 118 USPQ2d 1383, 1385 (TTAB 2016) citing *Fort Howard Paper Co. v. G.V. Gambina Inc.*, 4 USPQ2d 1552, 1553 (TTAB 1987) (“It is improper for a party to move for a protective order for the purpose of delaying service of the required responses and/or objections, or to harass one’s adversary by forcing the adversary to engage in motion practice.”).

c. The Third-Party is Unknown to Petitioner

Registrant closes its motion by offering that Petitioner be granted access to the non-disclosed documents provided a subpoena “issue to the other party to the agreement.” *See* Dkt. 13. Prior to Registrant moving for protective order, Petitioner was unaware of the alleged agreement between Registrant’s predecessor-in-interest (Lamprecht Ltd.) and a third party.

Petitioner is skeptical of Registrant’s suggestion because Petitioner does not know, nor does the motion disclose, among other things, (i) *the identity of* the third party, (ii) whether the third-party is a domestic or foreign entity, or (iii) whether the third-party remains an ongoing business or is defunct. As to this last unknown, Petitioner notes that the motion, makes no mention of *any* action taken by Registrant, as successor-in-interest to Lamprecht Ltd., to contact the undisclosed third party for permission to disclose the documents in this case. Accordingly, Registrant’s offering appears to be little more than a delay tactic clothed as a so-called solution.

IV. **Conclusion**

Petitioner respectfully submits that Registrant has not conferred or attempted to confer at all, let alone in in good faith, to resolve this matter without Board action and that Registrant has not shown good cause warranting a protective order. For these reasons, Petitioner respectfully requests that the Board deny Registrant's motion and order Registrant to immediately produce the responsive documents.

Dated: October 21, 2021

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Petitioner's Response in Opposition to Registrant's Motion for Protective Order was served on the following by delivering said copy on October 21, 2021, via email, to counsel for Registrant at the following address:

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/s/ Katherine A. Markert
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